

## **Remarks**

### **Claim Rejections – 35 USC § 103**

#### **Claims 1-5 and 7-12 over Johnson '638 in view of Kohler '541 and Heller '031**

These rejections are respectfully traversed on the grounds that the requirements of MPEP 2143 for the establishment of a *prima facie* case of obviousness have not been met and the cited references are insufficient for the establishment of a *prima facie* case of obviousness.

#### **Requirements for Establishment of *Prima Facie* Case of Obviousness**

According to MPEP 2143, for the establishment of a *prima facie* case of obviousness, there must be some suggestion or motivation to modify or combine the references, there must be a reasonable expectation of success if such a modification or combination is made, and the references must teach or suggest all the claim limitations.

#### **Lack of Suggestion or Motivation to Modify or Combine References**

As stated in the Office Action, Johnson '638 does not suggest joining without the barrier member. Also, contrary to what was stated in the Office Action, neither Kohler nor Heller provides any suggestion or motivation for a modification of, or a combination with, Johnson '638 and, more specifically, neither Kohler nor Heller provides any suggestion or motivation for eliminating the barrier member.

Kohler discloses methods and compositions related to heating and securing components together, but is completely silent with respect to a barrier member. In particular, since it does not address the opening of a flangeless seam after a sealing step, the Kohler reference provides no suggestion or motivation to modify the method of the Johnson *et al.* '638 reference to eliminate the barrier member. Likewise, the cited Heller *et al.* reference is completely silent with respect to a barrier member and provides no suggestion or motivation to modify the method of the Johnson *et al.* '638 reference to eliminate the barrier member.

#### **General Statements on Page 3 of Office Action**

In the Office Action, without identifying to which claims the comments pertain, it is stated that "Kohler and Heller provide clear motivation for using an adhesive having susceptor particles therein, the susceptor particles being heated by an electromagnetic field to activate the adhesive...[i]t would have been obvious...to provide Johnson '638 with an adhesive/susceptor joining means and the claimed step of applying an electromagnetic field because one having ordinary skill in the art would have been motivated to obtain the above stated benefits taught by Kohler and Heller." The "above stated benefits"

are described as “reducing the power requirements and avoiding damage to the substrates being bonded” for Kohler and “rapid and uniform generation of heat over the entire surfaces to be bonded” for Heller.

However, no need for any of these alleged benefits is expressed in Johnson ‘638, where the bonding methods used are described as sufficient and appropriate. Nor does Kohler or Heller express any possibility of applying either of their bonding methods to a stepwise process such as Johnson’s for folding, sealing, and unfolding layers to form a flangeless seam. Therefore, the mere fact that Kohler and Heller disclose or allege advantages for their bonding methods does not constitute suggestion or motivation to substitute Kohler’s or Heller’s bonding method for Johnson’s bonding method.

Instead, reference to the disclosures of Kohler and Heller leads no farther than to a conclusion that their bonding methods could have been substituted for Johnson’s. As clearly stated in MPEP 2143.01, the mere fact that references could have been combined or modified, or that the level of skill in the art may have been adequate to combine or modify them, is insufficient to establish a prima facie case of obviousness. In addition, given the utter lack of expression in Johnson of a need to improve the bonding methods used or of a desire to find an alternative bonding method, the statement that “one having ordinary skill in the art would have been motivated to obtain the above stated benefits taught by Kohler and Heller” is based on nothing more than either conjecture or the application of impermissible hindsight in light of the disclosure of the present invention.

Furthermore, the mere substitution of Kohler’s or Heller’s bonding method for Johnson’s bonding method is not sufficient to make the present invention, because either Kohler’s or Heller’s bonding method could be used with a barrier member. In other words, the mere substitution of Kohler’s or Heller’s bonding method for Johnson’s bonding method would not necessarily have any effect on whether or not a barrier member would be used and clearly would not necessitate the elimination of the barrier member.

#### General Statements on Pages 4 and 5 of Office Action

It is also stated in the Office Action, without identifying to which claims the comments pertain, that “Kohler teaches that the advantages of using an adhesive with susceptor particles heated by an electromagnetic field include controlling the bonding temperature to avoid overheating and limiting the heating to the bonding interface. One skilled in the art would have readily appreciated when using an adhesive with susceptor particles in the method of Johnson ‘638 **[not in the method of Johnson, but perhaps in place of Johnson’s method - MPH]** there is no need for the barrier member because such adhesives have the advantage of localized, controlled heating of the bond interface as taught by Kohler.

One skilled in the art would have appreciated that bonding the portions to be joined with such an adhesive so as to avoid bonding portions that are not meant to be joined by controlling the heating and placing the adhesive only in the area to be bonded, thereby eliminating the need for a barrier member. It would have been obvious...to provide Johnson '638 with an adhesive/susceptor joining means and the claimed step of applying an electromagnetic field because one having ordinary skill in the art would have been motivated to obtain the above stated benefits taught by Kohler and Heller and furthermore to perform the joining without a barrier member since the electromagnetic heating achieves controlled, localized heating only of the bonding interface, thereby eliminating the need for a barrier member".

However, even if the substitution of Kohler's or Heller's method for Johnson's bonding method would eliminate the need for a barrier member, it would not eliminate the barrier member, nor would it necessitate the elimination of the barrier member. Instead, either Kohler's or Heller's bonding method could be used with a barrier member. In other words, the mere substitution of Kohler's or Heller's bonding method for Johnson's bonding method would not necessarily have any effect on whether or not a barrier member would be used. In addition, given the utter lack of expression in Johnson of a need to improve the bonding methods used or of a desire to find an alternative bonding method, the statement that "one having ordinary skill in the art would have been motivated...to perform the joining without a barrier member" (underlining added) is based on nothing more than either conjecture or the application of impermissible hindsight in light of the disclosure of the present invention.

#### Statements Regarding Claims 1 and 12 in Office Action

The above arguments with respect to the general statements on pages 3, 4, and 5 of the Office Action apply to these claims.

#### Statements Regarding Claims 2, 3, 7, and 9 in Office Action

The above arguments with respect to the general statements on pages 3, 4, and 5 of the Office Action apply to these claims.

#### Summary of Arguments

Somehow, in the Office Action, the leap is made from Kohler's and Heller's disclosure of methods that could be used to a contention that one of skill in the art would be motivated to use them even in the complete absence of any expression of need. Then another leap is made to a contention that one of skill in the art would also be motivated to eliminate the barrier member because the substitution of the method

that could be used would eliminate the need for a barrier member. This path strays far from the analysis required by MPEP 2143 for the establishment of a *prima facie* case of obviousness.

In fact, none of the cited references provides suggestion or motivation to modify or combine the reference or references to make the invention of the subject application. In addition, a conclusion of obviousness with respect to the cited references is precluded by the prohibition of MPEP 2142 against impermissible hindsight based on applicants' disclosure and the recitations of MPEP 2143.01 with respect to the insufficiency of the mere fact that references could have been combined or modified, or that the level of skill in the art may have been adequate to combine or modify them. Therefore, the requisite suggestion or motivation to modify the Johnson *et al.* '638 reference to omit the barrier member is completely lacking.

#### Additional Issues Requiring Clarification

##### Rejection of Claim 3

One of the specific statements of rejection lists Claim 3 along with Claims 2, 7, and 9. However, nothing in that statement or in another specific statement of rejection is relevant to the specific limitation contained in Claim 3.

Thus, it is unclear from the Office Action whether or not any action is necessary with respect to Claim 3 and, if action is required, what action is appropriate. Clarification of this point is respectfully requested and an opportunity to respond on the basis of this clarification is also requested.

##### Rejection of Claim 4

It is respectfully pointed out that Claim 4 was referenced several times in statements explaining that Claim 1 and 12 were rejected because they do not contain the limitation of Claim 4 that the second member is provided in a folded configuration. Because Claim 4 is independent, this reference to Claim 4 as containing a limitation, the lack of which is stated to justify the rejections of Claims 1 and 12, raises the question of whether the inclusion of Claim 4 in the group of claims rejected under 35 USC § 103 was perhaps inadvertent. In other words, since Claim 4 contains the limitation, the lack of which prevents Claims 1 and 12 from being allowed, does this mean that Claim 4 is allowable?

The fact that Claim 4 was not mentioned in any of the specific statements of rejection except those explaining the rejections of Claims 1 and 12 seems to confirm the interpretation that the inclusion of Claim 4 in the group of claims rejected under 35 USC § 103 was inadvertent. Furthermore, if its inclusion was inadvertent, *i.e.*, if Claim 4 is actually allowable because of the limitation it contains (but

Claims 1 and 12 do not contain), then presumably Claim 5 through 11 are also allowable in their present form because they depend from Claim 4.

Thus, it is unclear from the Office Action whether or not any action is necessary with respect to Claims 4 through 11 and, if action is required, what action is appropriate. Clarification of this point is respectfully requested and an opportunity to respond on the basis of this clarification is also requested.

Rejections of Claims 8, 10, and 11

It is respectfully noted that none of Claims 8, 10, and 11 was mentioned in any of the specific statements of rejection. Furthermore, none of the specific statements of rejection mentions anything relevant to the specific limitations of these claims, so no correspondence of any specific statement of rejection to each of these claims can be discerned.

Thus, it is unclear from the Office Action whether or not any action is necessary with respect to Claims 8, 10, and 11 and, if action is required, what action is appropriate. Clarification of the rejections of these claims is respectfully requested and an opportunity to respond on the basis of this clarification is also requested.

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**Summary of Response**

In light of the above remarks, it is requested that the claim rejections be reconsidered and withdrawn and that the pending claims be allowed.

The issuance of a Notice of Allowance at an early date is respectfully requested.

Respectfully submitted,

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